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Paper No.: _____

SUBJECT : Request for Certificate of Correction for Appl. No. 10/032808 Patent No. 6750562

22

Please check reconsideration. See response lett. from Applicant 5/16/06
Please complete the response (see below) and forward the completed response to scanning
using document code COCX.

Elm
Certificates of Correction Branch
703-308-9390 ext. 117

The request for issuing the above-identified correction(s) is hereby:

☒ Approved

All changes apply.

☐ **Approved in Part**

Specify below which changes do not apply.

☒ Denied

State the reasons for denial below.

Comments: See Attachment

BRIAN SIRCUS

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

2836

SPE

Art Unit

Response to

Response to Notice Regarding Request for Certificate of Correction

Application 10032808

Patent 6750562

In this application, an original set of claims was received, with a date of 7/13/2001. This set of claims was incomplete, as can be seen by the fact that the last claim (number 23) on page 28 does not end in a period. Further, applicant's Fee Authorization sheet of 7/13/2001 indicates that 25 claims were filed. A preliminary amendment was filed on the same date 7/13/2001. This preliminary amendment cancelled claims 9 and 18, and amended claims 1, 10, 14, 16, 21 and 23. Claim 23 after entry of the preliminary amendment was then complete.

Due to the missing page of the originally filed set of claims at the time of entry of the preliminary amendment, the following claims were in the case, 1-8, 10-17, 19-23.

The examiner allowed this case in a first office action mailed 11/13/2003. The notice of allowability (PTOL 37) indicated the claims that the examiner had considered and this only included 1-8, 10-17, 19-21. However, the reasons for allowance accompanying the notice of allowability mentioned claim 23. The Issue classification page, an internal pto document, shows the examiner had renumbered the claims 1 through claim 23 to account for the cancellation of claims 9 and 18 in the preliminary amendment.

Applicant paid his issue fee 2/17/2004.

A supplemental notice of allowability was mailed 3/23/2004, indicating the same claims allowed as the original notice of allowability.

The record clearly demonstrates the examiner never had the claims available to be examined during prosecution of this application. Further, the applicant took no corrective actions when the two notice of allowabilities were mailed.

When an error in a patent is due to applicant's error, namely failure to respond to the two notice of allowabilities indicating the number of claims under consideration then MPEP 1481 states:

In re Arnott, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991) specifies the criteria of 35 U.S.C. 255 (for a Certificate of Correction) as follows:

Two separate statutory requirements must be met before a Certificate of Correction for an applicant's mistake may issue. The first statutory requirement concerns the nature, i.e., type, of the mistake for which a correction is sought.

The mistake must be:

- (1) of a clerical nature,
- (2) of a typographical nature, or
- (3) a mistake of minor character.

The second statutory requirement concerns the nature of the proposed correction. The correction must not involve changes which would:

- (1) constitute new matter or
- (2) require reexamination.

If the above criteria are not satisfied, then a Certificate of Correction for an applicant's mistake will not issue, and reissue must be employed as the vehicle to "correct" the patent. Usually, any mistake affecting claim scope must be corrected by reissue.

A mistake is not considered to be of the "minor" character required for the issuance of a Certificate of Correction if the requested change would materially affect the scope or meaning of the patent. See also MPEP § 1412.04 as to correction of inventorship via certificate of correction or reissue.

It is clear in the above fact pattern that the mistake is not minor because it affects the scope of the claims. These claims were never considered during prosecution and the certificate of correction shall not be granted placing claims in the patent that were never considered during examination of the patent.

Applicant's recourse in this application is through the reissue process.